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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,172	10/20/2003	Duane A. Lunsford	58683US003	2716

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/689,172	Applicant(s) LUNSFORD ET AL.	
	Examiner Daniel Zirker	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
4a) Of the above claim(s) 12-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 29-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/20/04</u> . | 6) <input type="checkbox"/> Other: ____ |

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-11 and 29-37, drawn to an adhesive article and a method of bonding an adhesive layer to a substrate, classified in Class 428, subclass 353.

II. Claims 12-28, drawn to an adhesive article and method of bonding an adhesive layer to a foam substrate, classified in Class 428, subclass 317.3.

2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions relate to significantly different structural adhesive coated articles and accompanying methods of formation wherein Group I substantially excludes the presence of acrylic based adhesives and Group II is directed to articles having foam substrates, consequently leading to different issues of patentability and different searches.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as

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shown by their different classifications, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Scott Bardell on May 11, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-11 and 29-37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37

CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. § 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. § 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double

patenting rejection based upon 35 U.S.C. § 101.

8. Claims 1-11 and 29-37 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-11 and 29-37 of copending Application No. 10/668,748. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

9. The following is a quotation of the second paragraph of 35 U.S.C. § 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicants regard as their invention.

10. Claims 1-11 and 29-37 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, in claims 1-11 the "adhesive" should be characterized as a --layer--. Additionally, the use of colons in Markush groups is not believed proper. With respect to the presence of "primer" in claims 1-11 it is believed that this should also be characterized as a --layer--, although in the method claims, particularly claims 36 and 37, the layer appears to be at some point a solution; it is not clear to the Examiner just exactly what is its intended state. Finally, the Examiner notes that in

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applicants' specification at page 11, lines 20-23 the term "consisting essentially of" appears to be defined in such a manner as to exclude (only?) the presence of an effective amount of a component that reacts with the adhesive or the substrate, such as an ambifunctional silane and/or any polymeric binder that might increase the adhesion of the adhesive layer to the substrate. Clarification is requested.

11. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-11 and 29-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lange et al., taken either individually, or for claims 6 and 32 in view of Melancon et al, US 2003/0152768, or for all the claims in view of EP 0372756B1, the latter two references taken as evidence of the state of the art. Lange et al. discloses (note particularly Figure 1, column 2 lines 35-57, column 3 lines 20-32, lines 47-51, column 4 lines

5-9, column 5 lines 1-15, lines 28-40, column 6 lines 1-10, the Examples) a closely related commonly assigned patent which discloses a very closely related genus of articles comprising a variety of suitable polymeric substrates such as polyester (column 3 lines 47-51, column 4 lines 5-9) which may be primed by a genus of silica nanoparticles formed in a gelled network which is believed to read upon applicants' claim language wherein it is stated that "the primer consists essentially of nanoparticles". Additionally, note that one of applicants' preferred trademark identified compositions, Nalco 2326, is also used as the colloidal silica in Lange et al. Additionally, it is noted that although applicants' claim language restricts the primer to "consists essentially of nanoparticles", at column 6 lines 1-10, particularly lines 1-2 the reference states that the coating ingredients may optionally contain a polymeric binder" but, of course, such is not required to be the case. However, although no adhesive compositions appear to be expressly taught in Lange et al, it is noted that the example teaches the utilization of the adhesive layer found on 3M's trademark identified Scotch Brand Magic Transparent Tape, which is believed to teach the utilization of acrylic based pressure sensitive adhesives. Although these may well be acrylic based adhesives which applicants' chosen claim language is believed to exclude, the

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Examiner believes that it is a parameter that is well within the ordinary skill of the art to utilize other adhesives besides acrylics. Alternatively, note as evidence of the state of the art EP -756, which discloses an extremely closely related primed article wherein it is taught at page 3 lines 9-15, particularly lines 14-15, that a wide variety of pressure sensitive adhesives are generally suitable for being coated on such articles. Finally, the Examiner notes that the process of making the invention involves forming a coating of the primer, which is also believed to reduce applicants' method claims to being well within the ordinary skill of the art to fabricate in view of what has been previously stated. With respect to the dependent claims, note that Melancon et al teaches the use of silicone polyurea based adhesives, and that such parameters as the specific adhesives, nanoparticles and polymer substrates are believed to be, if not either expressly or inherently disclosed, obvious modifications to one of ordinary skill, in the absence of unexpected results.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

May 17, 2005

DANIEL ZIRKER
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Daniel Zinker". The signature is written in a cursive, flowing style.